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DATE: October 28, 2003

TO: Donald Hajec
Director, Technology Center 3670

FROM: Robert J. Spar
Director, Office of Patent Legal Administration

SUBJECT: Remand of Application 09/703,277 in view of *Ex Parte Eggert et al.*

Application No. 09/703,277 has been remanded to the examiner from the Board of Patent Appeals and Interferences (BPAI) in view of its precedential opinion, *Ex Parte Eggert et al.*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003). The remanded application is being returned to the Technology Center, via the Office of Patent Legal Administration (OPLA), for reconsideration of the recapture rejection under 35 U.S.C. 251, made by the examiner of record on September 10, 2002, in the examiner's answer, Paper No. 22, in view of *Eggert*.

To assist the Technology Center in evaluating the remanded application, OPLA has conducted a preliminary review of the application file, its contents, and the recapture rejection found in Paper No. 22. These findings are attached. In light of this preliminary review, OPLA recommends that the following action be taken by the examiner with respect to the application file:

Withdraw the appealed recapture rejection (the sole rejection on appeal) as being no longer appropriate in view of *Eggert* identified in the attached remarks. The attached remarks by OPLA present a rationale for the recommended withdrawal of the rejection and may be used in the next action taken by the examiner.

Further Assistance: For questions relative to the materials provided above, please contact Ken Schor at 308-6710, or Joe Narcavage at 305-1795, both of the Office of Patent Legal Administration, or by e-mail. For questions as to recapture in general, the examiners should consult the Special Program Examiners (SPREs) of the Technology Centers.

Attachment: OPLA Comments Paper

BPAI REMAND
APPL. NO. 09/703,277

A recapture rejection would not be appropriate in the present reissue application in view of the following analysis.

Original independent claim 1 in the parent application included the broad limitation of:

“a means for rotatably connecting said rails to said stanchions (emphasis added).”

The following limitations of dependent claims 2, 3 and 4 were all added to the “rotatably connecting means” of claim 1 to obtain allowance of the patent claims in the original application for patent:

“said connecting means including a first threaded stud outwardly projecting from a top end of said stanchions in substantially axial alignment therewith enabling each of said upper side rails to be rotatably mounted thereon at various angles (limitations of claim 2),

said upper side rails being pivoted in a vertical plane at varying angles by use of angulation means (limitations of claim 3),

said angulation means comprising a generally L-shaped swivel bracket disposed on said first threaded stud at said top end of said stanchions, said L-shaped bracket including a long leg portion and a short leg portion being fixedly attached in perpendicular relation thereto, said bracket further including swiveling means being adapted for pivoting movement in a plane parallel to the plane defining said long leg portion, said swiveling means including a second threaded stud disposed in perpendicular relation to said axis of said stanchion enabling said upper side rails to be mounted thereon and pivoted in a vertical plane at varying angles for installation of said temporary guardrail system on inclines such as stairs. (limitations of claim 4)”

The above limitation has been modified in the only independent reissue claim, claim 12, as follows¹:

“said connecting means including a first threaded stud outwardly projecting from a top end of said stanchions in substantially axial alignment therewith enabling each of said ~~upper~~ side rails to be rotatably mounted thereon at various angles,

said ~~upper~~ side rails being pivoted in a vertical plane at varying angles ~~by use of angulation means,~~

¹ The strikethrough and underlining show the changes made in each reissue claim relative to the cover piece limitation as it existed in the original patent claims.

~~said angulation means comprising a generally L-shaped swivel bracket disposed on said first threaded stud at said top end of said stanchions, said L-shaped bracket including a long leg portion and a short leg portion being fixedly attached in perpendicular relation thereto, said bracket further including swiveling means being adapted for pivoting movement in a plane parallel to the plane defining said long leg portion, said swiveling means including a second threaded stud disposed in perpendicular relation to said axis of said stanchion enabling said upper side rails to be mounted thereon and pivoted in a vertical plane at varying angles for installation of said temporary guardrail system on inclines such as stairs."~~

Original application claim 1 was drawn to a temporary guardrail system having vertical stanchions and upper and lower side rails and included a broadly claimed *means for rotatably connecting* said rails to said stanchions. Original application claim 2 which depended from claim 1 added the limitation that the connecting means included a "axially threaded stud" for rotatable connection of the side rails. Original application claim 3 which depended from claim 1 added the limitation that the connecting means included angulation means, and original application claim 4 which depended from application claim 3 added the specific L-shaped bracket structure of the angulation means. These limitations were all added to claim 1 in the amendment of December 2, 1997, (paper No. 12). It is clear from the remarks on page 3 of the December 2, 1997, amendment that applicant gave up the broad rotatably connecting structure of application claim 1, and relied upon the inclusion into application claim 1 of the above noted limitations of application claims 2, 3 and 4 as the basis for obtaining the patentability of patent claim 1.

The reissue claims broaden the limitation of the "*means for rotatably connecting*" in patent claim 1 by deleting the "angulation means" (of original application claim 3) and the specific "L-shaped bracket structure" (of original application claim 4) while retaining the "axially threaded stud" limitation (of original application claim 2) for rotatable connection of the side rails. Because the limitations of claim 2 remain in reissue claim 12, the reissue claim is still narrower than the canceled claims (i.e., the claims before any limitations to the "*rotatably connecting*" was added to obtain allowance). Thus, the reissue claims provide a narrowing of the canceled claims in the area of the surrender.

Thus, *Ex parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003) (a precedential opinion of an expanded panel of the Board) is on point, and it is suggested that the appealed rejection which is based on recapture be withdrawn by the examiner, and the content of the above be used in the next action taken.

The above analysis of the claims was solely directed to, and limited to, the legal issue of whether the recapture rejection should be maintained or not. Unless specifically identified above, additional issues such as prior art rejections and compliance with 35 U.S.C. 112 have not been addressed, and a general screening of the case has not been carried out. Accordingly, if the application is allowed, further review by the TC SPRE as per MPEP 1456 will be provided.